

§ 2.36

(7) When the applicant deletes a basis, the applicant must also delete any goods, services, or collective membership organization covered solely by the deleted basis.

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, or a collective membership organization, the applicant may not amend the application to seek registration under section 1(a) of the Act for identical goods or services or the same collective membership organization, unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

§ 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application if the owner(s) last listed in Office records of the prior registrations differs from the owner(s) listed in the application.

[80 FR 2310, Jan. 16, 2015]

§ 2.37 Description of mark.

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

[73 FR 13784, Mar. 14, 2008]

§ 2.38 Use by predecessor or by related companies.

(a) If the first use of the mark was by a predecessor in title or by a related company (sections 5 and 45 of the Act), and the use inures to the benefit of the applicant, the dates of first use (§§ 2.34(a)(1) (ii) and (iii)) may be asserted with a statement that first use was by the predecessor in title or by the related company, as appropriate.

(b) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

(Sec. 5, 60 Stat. 429; 15 U.S.C. 1055)

[30 FR 13193, Oct. 16, 1965, as amended at 54 FR 37589, Sept. 11, 1989; 64 FR 48920, Sept. 8, 1999; 80 FR 2310, Jan. 16, 2015]

37 CFR Ch. I (7–1–15 Edition)

§ 2.39 [Reserved]

§ 2.41 Proof of distinctiveness under section 2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with § 2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with § 2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods or services.

(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with § 2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

[54 FR 37590, Sept. 11, 1989, as amended at 73 FR 67768, Nov. 17, 2008]

EFFECTIVE DATE NOTE: At 80 FR 33180, June 11, 2015, § 2.41 was revised, effective July 11, 2015. For the convenience of the user, the revised text is set forth as follows:

§ 2.41 Proof of distinctiveness under section 2(f).

(a) *For a trademark or service mark—*(1) *Ownership of prior registration(s).* In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same

mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(b) *For a collective trademark or collective service mark—(1) Ownership of prior registration(s).* See the requirements of paragraph (a)(1) of this section.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a collective trademark or collective service mark is said to have become distinctive of the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the members' goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(c) *For a collective membership mark—(1) Ownership of prior registration(s).* In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods, services, or nature of the collective membership organization are sufficiently similar to the collective membership organization in the application; however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a collective membership mark is said to have become distinctive of indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of indicating membership in the applicant's collective membership organization, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the members' use in commerce, and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(d) *For a certification mark—(1) Ownership of prior certification mark registration(s).* In appropriate cases, ownership of one or more active prior certification mark registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the authorized users' goods or services are sufficiently similar to the goods or services certified in the application, subject to the limitations of the statement set forth in § 2.45(a)(4)(i)(C); however, further evidence may be required.

(2) *Five years substantially exclusive and continuous use in commerce.* In appropriate cases, if a certification mark is said to have become distinctive of the certified goods or services by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may

§ 2.42

37 CFR Ch. I (7–1–15 Edition)

be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) *Other evidence.* In appropriate cases, where the applicant claims that a mark has become distinctive of the certified goods or services program, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the authorized users' use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

(e) *Certification marks with geographical matter.* Paragraph (d) of this section does not apply to geographical matter in a certification mark certifying regional origin because section 2(e)(2) of the Act does not apply to certification marks that are indications of regional origin.

§ 2.42 Concurrent use.

An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of the applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

[54 FR 34897, Aug. 22, 1989]

EFFECTIVE DATE NOTE: At 80 FR 33181, June 11, 2015, § 2.42 was revised, effective July 11, 2015. For the convenience of the user, the revised text is set forth as follows:

§ 2.42 Concurrent use.

(a) Prior to seeking concurrent use, an application for registration on the Principal Register under the Act must assert use in commerce and include all the application elements required by the preceding sections, in addition to § 2.44 or § 2.45, if applicable.

(b) The applicant must also include a verified statement that indicates the following, to the extent of the applicant's knowledge:

(1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;

(2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

(c) For the requirements to amend an application to concurrent use, see § 2.73.

(d) For the requirements of a concurrent use proceeding, see § 2.99.

§ 2.43 Service mark.

In an application to register a service mark, the application shall specify and contain all the elements required by the preceding sections for trademarks, but shall be modified to relate to services instead of to goods wherever necessary.

(Sec. 3, 60 Stat. 429; 15 U.S.C. 1052)

§ 2.44 Collective mark.

(a) In an application to register a collective mark under section 1(a) of the Act, the application shall specify and contain all applicable elements required by the preceding sections for trademarks, but shall, in addition,